

REMARKS

Applicants submit this Amendment in reply to the Office Action mailed October 3, 2006. In the Office Action, the Examiner rejected claims 1-5 under 35 U.S.C. § 102(e) as being anticipated by U.S. Published Patent Application No. 2004/0114245 to Takahashi et al.

By this Amendment, Applicants amend claims 1, 2, and 5 and add new claims 6 and 7. The originally-filed specification, claims, and drawings fully support the subject matter of amended claims 1, 2, and 5 and new claims 6 and 7. Claims 1-7 are pending in the above-captioned patent application. Of these, claims 1 and 5-7 are independent.

New claims 6 and 7 are similar to independent claims 1 and 5, respectively, except that they recite “an aberration correcting optical element” instead of “a chromatic aberration correcting optical element.” Support for new claims 6 and 7 may be found in the specification, for example, in the paragraph bridging pages 11 and 12.

Applicants respectfully traverse the Examiner’s rejection of claims 1-5 under 35 U.S.C. § 102(e) as being anticipated by Takahashi et al. In order to establish that Takahashi et al. anticipates Applicants’ claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Here, Takahashi et al. at least fails to teach the claimed objective lens, whose center of gravity "is arranged substantially on a straight line connecting supporting points of a lens holder for the objective lens," as recited in claims 1 and 5.

Takahashi et al. discloses a lens barrel 58 containing a first lens L1 and a second lens L2. See Fig. 18. Lenses L1 and L2, together comprising objective lens 15, are separated by spacing d2. See Fig. 28. The objective lens 15 sits on movable base 14, as shown in Fig. 4.

Even assuming that the structure of objective lens 15 meets the other recitations of claims 1 and 5, which Applicants do not concede, Takahashi et al. does not disclose or suggest a center of gravity of objective lens 15 that "is arranged substantially on a straight line connecting supporting points of a lens holder for the objective lens." Nowhere does Takahashi et al. disclose where, along lens barrel 58, movable base 14 will fall in relation to the center of gravity of objective lens 15. Thus, the claimed location of the center of gravity of objective lens 15 is not expressly disclosed in Takahashi et al.

The Office Action apparently acknowledges the lack of express disclosure by failing to clearly identify teachings of the precise location of the center of gravity of objective lens 15. Instead, the Examiner asserts,

[S]ection [0189 and 0190] describes that the design will cancel out the resonant oscillation on application of the focusing servo and tracking servo [and] is enabled by adjusting d2 to shift the position of center of gravity of objective lens 15, ... *which is therefore taken to be the same as the recited center of gravity arrangement*, as set forth in the claims.

Office Action at pages 2-3, emphasis added. Accordingly, Takahashi et al. does not expressly teach the claimed location of the center of gravity.

To the extent that the Examiner contends that the claimed location of the center of gravity is inherently disclosed in Takahashi et al., Applicants respectfully note that “[t]he fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” M.P.E.P. Section 2112 (IV). In order to inherently disclose the claimed center of gravity, the reference would have to disclose *only one* spacing d2 corresponding to *one* center of gravity location. Applicants advise that, in Takahashi et al., resonant oscillations are cancelled out over a *range* of spacings d2. Takahashi et al. fails to teach that the center of gravity of objective lens 15 *must* be located at a single position corresponding to the claimed center of gravity, “arranged substantially on a straight line connecting supporting points of a lens holder for the objective lens,” in order to cancel the resonant oscillations. Accordingly, Takahashi et al. does not *necessarily* require that the center of gravity be located at a position satisfying claims 1 and 5. As such, Takahashi et al. fails to teach, inherently or otherwise, the claimed center of gravity for at least this additional reason.

Additionally, Applicants note that in order for Takahashi et al. to be anticipatory, it must include an enabling disclosure. See M.P.E.P. Section 2131.01(I). Takahashi et al.’s teachings of changing the distance d2 to adjust the center of gravity of objective lens 15 (see paragraph [0189]) after the lenses L1 and L2 are assembled, however, would defocus objective lens 15 and would render the entire device inoperable. Thus, Takahashi et al. is not enabling for the teachings relied upon by the Examiner. For this additional reason, the rejection based on Takahashi et al. should be withdrawn.

Applicants further note that in contrast to Takahashi et al., the claimed invention, to prevent resonant oscillations, places the position of the center of gravity on a straight line connecting supporting points of a lens holder for the objective lens, instead of changing the distance between lenses.

For all of the reasons described above, claims 1 and 5 are allowable over Takahashi et al., and claims 2-4 are allowable at least due to their dependence from claim 1.

Moreover, with respect to claim 4, Applicants note that Takahashi et al. discloses a one-element convex lens L2 in objective lens 15. See Takahashi et al., Figs. 5, 17-20, 22, 24, 26 and 28. Nowhere does Takahashi et al. disclose a two-element convex lens as recited in claim 4. Claim 4 is thus allowable over Takahashi et al. for this additional reason.

New claims 6 and 7, while of different scope, recite features similar to those recited in claims 1 and 5. Claims 6 and 7, therefore, are allowable at least for the reasons discussed above in regard to claims 1 and 5.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

In discussing the specification and claims in this Amendment, it is to be understood that Applicants are in no way intending to limit the scope of the claims to

any exemplary embodiments described in the specification or abstract and/or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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